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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/849,574	05/18/2004	Edward Almond	3215-GB-US-C1	6343
21378 7590 09/11/2009 APPLIED MEDICAL RESOURCES CORPORATION 22872 Avenida Empresa Rancho Santa Margarita, CA 92688				
EXAMINER SCHELL, LAURA C				
ART UNIT		PAPER NUMBER		
3767				
MAIL DATE		DELIVERY MODE		
09/11/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/849,574

**Applicant(s)**

ALMOND ET AL.

**Examiner**

LAURA C. SCHELL

**Art Unit**

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**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 June 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,4-7 and 9-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-7 and 9-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 and consequently all dependent claims are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Lines 10-12 of claim 1 recite that the follower member of each of the jaws is received in a corresponding guideway of the actuator. However, upon reviewing Applicant's drawings and specification, it appears that it is not the follower member but the lug that is received in the guideways of the actuator, and that the follower member is received in the plurality of guideways of the base. Appropriate correction is required and if the examiner is mistaken in the interpretation of the drawings and specification, explanation is requested.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 2, 4-7 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carlson et al. (US Patent No. 5,820,600) in view of Konig (US Patent No. 4,513,948). Carlson discloses the device substantially as claimed including a seal for laparoscopic port comprising a base (8) adapted to engage a cannula, the base including an axial aperture (Figs. 4-5b: 62, 116) for a surgical instrument (Fig. 4, 130 for example) and a plurality of guides (col. 9, lines 53 through col. 10, lines 1-19 disclose that the jaws 110 move radially inward and slide along a track/groove that is not shown); a multiplicity of jaws (Figs. 5a and 5b; 110) mounted on the base, the jaws being moveable radially along the plurality of guides with respect to the aperture between an open position wherein the shaft of the surgical instrument may pass freely and the closed position wherein the jaws engage the shaft and provide a restraining force restraining radial movement of the shaft (Figs. 5a and 5b; col. 9, lines 53 through col. 10, lines 1-19 disclose that the jaws 110 move radially inward and slide along a track/groove that is not shown. These passages further disclose that the movement of jaws 110 may be "actuated by movement of ring 50 so that the size of central opening 116 corresponds to the size of aperture 62" col. 10, lines 15-18. Furthermore, col. 3,

line 65 through col. 4, line 14 discloses that the second valve member 50 may be threadably coupled to the device so that rotation of 50 relative to the device causes the aperture to increase and decrease in size for sealing around different sized instruments. Therefore the jaws 110 can be moved by rotation.) and the multiplicity of jaws each comprising a follower member extending therefrom (any portion of 110 extending from the portion that is attached to the septum can be interpreted as the follower member, as no other structure has been claimed regarding the follower member); and a diaphragm adapted to contact the shaft of a surgical instrument extending through the aperture (60); wherein the diaphragm includes a lip (Fig. 1 discloses that the interior edge 62 can be considered a lip), each jaw including a radially outwardly facing portion adapted to engage the lip so that the aperture of the diaphragm is forced open as the jaws move to an open position (Fig. 5a discloses that each of 110 extends over a portion of the diaphragm 60 and Fig. 4 discloses that portions of 50 including radially outwardly facing portions to engage the lip of the diaphragm, since 110 is used to move the diaphragm it is reasonably obvious that each of 110 would have a radially outwardly extending portion adapted to engage the lip to move the diaphragm open and closed as Fig. 4 shows a lip engaging portion (please see annotated Fig. 4 at the end of the office action)). While Carlson discloses that portion 50 may be rotated in order to move the jaws 110 open and closed (col. 9, lines 53 through col. 10, lines 1-19 and col. 3, line 65 through col. 4, line 14), Carlson does not disclose a separate actuator with a plurality of guideways formed therein, where the follower member of each jaw is received in one of each of the plurality of guideways. König, however, discloses a seal system (Figs. 1-9)

in which there is a base member (2) with a plurality of guides (17, most easily seen in Fig. 3), multiple jaws mounted to the base (8), each jaw having a follower member (Fig. 1, follower member being comprised of 13/14/15) as well as an actuator (9), the actuator also having a plurality of guideways formed therein (fig. 2, 23/23a) wherein the top portion of each follower is received within the guideways (Figs. 2 and 9). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Carlson's device with an actuator with a plurality of guideways receiving the follower of the jaws, as taught by Konig, in order to provide a cover portion for the seal actuator which would protect and slave the jaws from accidentally being damaged by the insertion or removal of a medical instrument and ruining the function of the seal.

In reference to claim 2, Carlson discloses that the jaws may be adjusted to engage a shaft having any diameter between pre-selected upper and lower limits (Figs. 5a and 5b; col. 3, lines 65 through col. 4, line 14 disclose rotation and col. 6, line 3-6 disclose that rotation of the actuator is linked to discrete size settings/diameters).

In reference to claim 4, Konig discloses that the guides on the base comprise channels between raised formations, tracks or runners (Fig. 3, 17).

In reference to claim 5, Konig discloses that the follower member of each jaw comprises a lug adapted to be received in the corresponding guideway in the actuator arranged so that rotation of the actuator causes radial movement of the jaw (Fig. 1, portions 13/15).

In reference to claim 6, König discloses that the guideway in the actuator comprises an arcuate channel formed in the actuator (Fig. 2, 23/23a).

In reference to claim 7, König discloses that the channels have the configuration of parabolic curves (Fig. 2).

In reference to claim 9, Carlson discloses that the radially outwardly facing portion of each jaw comprises a hook (see annotated version of Fig. 5 at the end of the office action).

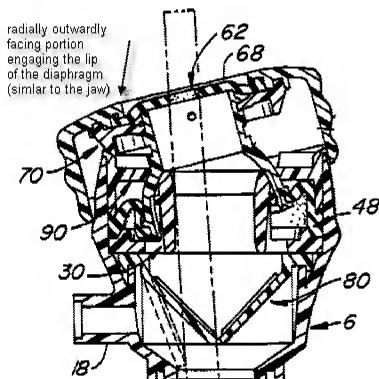
In reference to claim 10, Carlson discloses that the aperture of the jaws is continuously adjustable between maximum and minimum positions (Figs. 5a and 5b).

In reference to claim 11, Carlson discloses that the jaws may be fully opened or closed by a rotation through an angle of 30-180 degrees (Figs. 1, 5a and 5b; col. 6, lines 3-6 and col. 3, lines 65 through col. 4, line 14).

Claims 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carlson et al. (US Patent No. 5,820,600) in view of König (US Patent No. 4,513,948) and further in view of Smith (US Patent No. 7,025,747). Carlson in view of König discloses the device substantially as claimed except for shield members moving with and covering the jaws. Smith, however, discloses a similar device (Figs. 15-18b) with jaws that are rotated (Figs. 18a and 18b, 960 for example) to engage the instrument as well as shield members (969 for example). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Carlson in

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view of König with the shield members, as taught by Smith, in order to provide shielding and protection for the moving mechanisms to prolong the use of the device and protect it from premature wear and tear.



### ***Response to Arguments***

Applicant's arguments with respect to claims 1, 2, 4-7, 9-16 have been considered but are moot in view of the new ground(s) of rejection.



***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **LAURA C. SCHELL** whose telephone number is (571)272-7881. The examiner can normally be reached on Monday-Friday 9am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Simons can be reached on (571) 272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Laura C Schell/  
Examiner, Art Unit 3767  
/Kevin C. Simmons/  
Supervisory Patent Examiner, Art Unit 3767